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Paper No. 13
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The 67 Liquor Shop, Inc.

Serial No. 75/724,894

Bruce E. Lilling of Lilling & Lilling for applicant.

Alex S. Keam, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Quinn, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by The 67 Liquor Shop,
Inc. to register the mark WALL STREET WINE EXCHANGE for
"wine brokerage services."¹

Registration has been refused by the Trademark
Examining Attorney under Section 2(d) of the Trademark Act
on the ground that applicant's mark, as used in connection

¹ Application Serial No. 75/724,894, filed June 9, 1999, alleging a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth dates of first use of May 29, 2000.

with applicant's services, so resembles the previously registered mark WALL STREET for "whiskey"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed.³ Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that the marks are highly similar and that the goods and services are related. As to the later point, the Examining Attorney asserts that wine and whiskey often emanate from a common source and that these goods travel in the same trade channels. The Examining Attorney goes on to state that it is "common practice for retailers to sell goods featuring the same mark as its store" and that "[c]onsumers are likely to believe that the applicant's wine brokerage services feature whiskey with the same brand name as the services, or that the whiskey is provided by the same party as the source of the wine brokerage services." The Examining Attorney argues that retailers are likely to be confused as well. In response to applicant's argument based on laws

² Registration No. 963,057, issued July 3, 1973; renewed.

³ The final refusal also was based on applicant's failure to comply with a requirement to disclaim the words "Wine Exchange" apart from the mark. Applicant, in its reply brief, proffered a disclaimer in compliance with the requirement. Accordingly, the issue is moot, and a disclaimer of the words "Wine Exchange" has been entered in the file.

prohibiting the same entity from distilling and also selling the alcoholic beverages, the Examining Attorney states that consumers may not even be aware of such laws. In support of the refusal, the Examining Attorney submitted excerpts retrieved from the NEXIS database and the Internet, and third-party registrations, all of which show, according to him, that wine and whiskey may emanate from the same source.

Applicant readily concedes that the marks are similar, stating that "[a]s self apparent here, the principal portion of each of the marks is WALL STREET, so the consideration [of likelihood of confusion] necessarily revolves around the similarity or dissimilarity between the goods and services." Applicant asserts that the alcoholic beverage industry is heavily regulated by governmental laws, and that there is a very clear demarcation between distillers on the one hand and sellers on the other hand. Applicant points to federal and state laws that prevent the same entity from distilling alcoholic beverages and then also acting as a direct seller of them to the public. In response to the Examining Attorney's evidence, applicant argues that the relatedness of wine and whiskey is not the specific comparison to make here, but rather wine brokerage services and whiskey must be compared. Applicant states

that there is no evidence that consumers expect a single source to be responsible for both wine brokerage services and whiskey, and, moreover, that it is legally impossible for any company to both produce distilled alcoholic beverages and directly sell them. In support of its position, applicant submitted the declaration of Bernard Weiser, applicant's president. Mr. Weiser attests to federal and New York state laws providing that distillers are not permitted to sell at retail directly to the consuming public; rather, the distillers sell their alcoholic beverages to distributors who, in turn, sell them to retail stores for ultimate distribution to purchasers. With its reply brief, applicant submitted a copy of its recently issued (June 19, 2001) Registration No. 2,462,666 for the mark WALL STREET for services including "wine trading and wine brokerage."⁴

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d

⁴ Although the submission is technically untimely, a remand of the application to the Examining Attorney would have been warranted inasmuch as this evidence was not previously available. Thus, we have considered the registration. We hasten to add, however, that, even in its absence, we would have reached the same result on the merits.

1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's mark WALL STREET WINE EXCHANGE and registrant's mark WALL STREET are similar in sound, appearance and meaning. Applicant does not disagree and, thus, we turn to focus our attention, as has applicant, on a comparison of applicant's wine brokerage services with registrant's whiskey.

The recitation of services in the application and the identification of goods in the cited registration control the legal comparison herein. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We recognize, at the outset of our consideration, that the Examining Attorney's evidence suggests that whiskey and wine may emanate from a single source. We agree with applicant, however, that its services are "one step removed" from wine. While the evidence shows that whiskey and wine are broadly related in that both are alcoholic beverages, nevertheless, there is a clear distinction between whiskey and wine brokerage services. The record is

devoid of any evidence suggesting that these specific goods and services, namely "whiskey" and "wine brokerage services," may emanate from a common source. Moreover, as highlighted by applicant, the likelihood of confusion scenarios advanced by the Examining Attorney are not realistic given the federal laws preventing a distiller of alcoholic beverages from also acting as a retailer of alcoholic beverages.

Based on the record before us, we see the Examining Attorney's view of the likelihood of confusion as amounting to only a speculative, theoretical possibility, especially in view of the distinction between the goods and services and the highly regulated nature of the alcoholic beverage industry. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), *citing* Witco Chemical Co. v. Whitfield Chemical Co., Inc.,

Ser No. 75/724,894

418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*
153 USPQ 412 (TTAB 1967).

Decision: The refusal to register is reversed.